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Gary M. Johnson

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APPLIED MEDICAL RESOURCES CORPORATION

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EXAMINER

HALL, DEANNA K

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



## DETAILED ACTION

### *Acknowledgments*

1. This office action reopens prosecution in response to the appeal brief received 4/5/10.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 4, 6, 8-13, 25-26, 40-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Popov et al. (US 7,422,572) ("Popov").** Popov discloses a surgical access port comprising:

An elongate tubular body 8 having a lumen 10 dimensioned to be capable for the passage of surgical instruments 2 therethrough, and a tissue penetrating tip 31 connected to and disposed at the distal end of the tubular body capable of penetrating through a body wall; the tip in a first, penetrating position blocks the lumen of the elongate body and the tip is capable of swinging from the first penetrating position to a second, retaining position to unblock the lumen of the elongate body, see Figs. 8-9.

The tip 31 of Popov is substantially blunt or has a conical surface Fig. 1.

The tip of Popov further is capable of remaining in an off-axis condition until removal of the access port whereby it is then capable of realigning with the axis of the tubular body. The repositioned tip of Popov is capable of remaining in a substantially right-angled condition.

The tubular body 8 is a thin walled tube size and configured to allow passage of surgical instruments 2, Fig. 3.

The conical surface of the tip of Popov 31 facilitates insertion of the access port with a reduced penetration force and minimizes tenting of the body wall and also facilitates separation of different layers of the body wall and provides proper alignment of the tip between the layers in the same way as applicant's blunt or conical tip as claimed in claim 4.

The tip of Popov is a non-expanding tip and a non-compressible tip. The tip is a single-piece tip, Fig. 3.

The lumen 10 of Popov is dimensioned for the passage of surgical instruments 2.

(Claim 8) The tip 31 of Popov does reposition to one side of the tubular body, Fig. 3. However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 2, 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popov in view of Roth (US 5,626,598).**

Popov discloses the invention as substantially claimed (see above). However, wherein Popov discloses a surgical instrument (needle 2) enclosed in the tubular body 8, Popov does not directly disclose a port with an opening sealed by a seal housing and opened into the tubular body to allow passage of surgical instruments. Roth, in the analogous art teaches this feature C6 L30-34, obturator of Roth. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Popov with the seal housing as taught by Roth for sealing the opening when surgical instruments are passed through.

Further, Roth demonstrates the variation of tips available for insertion into a body cavity. The sharp, pointed or bladed tips Figs. 8, 10, 12, 14, 16, 18 are shown as being interchangeable with the blunt or conical tip Fig. 20.

**6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Popov.**

Popov discloses a tubular body 8 having a tip 31. Popov does not address the materials used to form the tubular body or the tip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make at least one

of the tubular body and tip from an optically clear material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

### ***Response to Arguments***

7. Applicant argues that the portion 8 of Popov is not an elongate tubular body with a lumen dimensioned for the passage of surgical instruments therethrough. This argument is not persuasive. Tubular as defined by the Oxford dictionary (via [www.onelook.com](http://www.onelook.com)) is defined as long, round and hollow, with hollow being defined by the Merriam-Webster dictionary (via [www.onelook.com](http://www.onelook.com)) as an unfilled space. There is no mention of a tube having to have a closed cross section as applicant argues. Further, with the needle 6 removed in Popov the lumen 10 would be cleared for insertion of another surgical instrument. Thus Popov discloses an elongate tubular body 8 with a lumen 10 dimensioned for the passage of surgical instruments therethrough (either the needle 2, or another surgical instrument), Figs. 1-3.

8. Next applicant argues that the tip 31 of Popov is not a tissue penetrating tip. This argument is not persuasive. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, the lid 31 is capable of penetrating through a body wall and into the body cavity. Further

note, if applicant's claim 4 is blunt and capable of penetrating a tissue wall then so is the blunt or conical tip 31 of Popov.

9. Popov does disclose a thin walled tube as in claim 12. See rejection above.

10. Applicant argues that Popov does not disclose the tip in the first penetrating position blocking the passage of an opening at the distal end preventing passage of surgical instruments; the tip in the second retaining position unblocking the passage allowing for passage of surgical instruments; and a repositioned tip that remains off-axis until removal of the access port. These arguments are not persuasive. The tip in the first position of Popov is closed for passage of surgical instruments and the tip in the second position is open for passage of surgical instruments, Figs. 8-9. Removal of the tubular body would automatically close the tip 31 once force was generated on it. Note that the swinging of the tip in claim 1 is not read as an automatic action. The examiner recognizes the automatic action of this movement in claim 8 therefore it is not proper to read this action into claim 1.

11. With regard to applicants arguments that the tip in Popov is not a non-expanding tip or a non-compressible tip these arguments are not persuasive. The drawings of Popov clearly demonstrate no expansion or compression of the tip 31, Figs. 6-9. This feature is not explained in applicant's specification and only seen in applicant's drawings in the same way in which it is seen in Popov's drawings.

12. The arguments against the combination of Popov and Roth are now moot due to withdrawal of the 103(a) rejection and replacement with the 102(e) rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEANNA K. HALL whose telephone number is (571)272-2819. The examiner can normally be reached on M-F 11:00am-7:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deanna K. Hall/  
Examiner, Art Unit 3767  
7/15/10

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